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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,656	09/26/2005	Junbiao Zhang	PU020392	8433

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EXAMINER	
SHOLEMAN, ABU S	

ART UNIT	PAPER NUMBER
4148	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/524,656	ZHANG ET AL.	
	Examiner	Art Unit	
	ABU SHOLEMAN	4148	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 February 2005* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *02/17/2005 and 06/20/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This instant application having application NO.10/524656 filed on 09/26/2005 is presented for examination by the examiner.

Oath/Declaration

2. The applicants' oath/declaration had been reviewed by the examiner and is found to conform to the requirements prescribed in **37.C.F.R.1.63.**

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on The information disclosure statement (IDS) submitted on 06/20/2008 and 02/17/2005 have been acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

4. The informal drawings are not of sufficient quality to permit examination. Accordingly, replacement drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to this Office action. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

Applicant is given a TWO MONTH time period to submit new drawings in compliance with 37 CFR 1.81. Extensions of time may be obtained under the

provisions of 37 CFR 1.136(a). Failure to timely submit replacement drawing sheets will result in ABANDONMENT of the application.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1,11 and 16 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter for the following reason:

The claims fail to place the invention squarely within on statutory class of invention. On page 3, paragraph 0009, lines 7-8 of the instant specification, applicant evidence that applicant intends the 'watermark" to include output signal. As such, the claims are drawn to a form of signal. Signal is not on of the four categories of invention and therefore this claims are not statutory. Signal is not a series of steps or acts and thus is not a process. Signal is not physical article or object and such is not a machine or manufacture. Signal is not a combination of substance and therefore not a composition of matter.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-10 are rejected under 35 U.S.C.103(a) as being unpatentable over Sasaki et al (US 6735699)(hereinafter Sasaki) in view of Jian Zhao(Applying digital watermarking Techniques to online Multimedia Commerce) (hereinafter Jian).

As per claim 1, Sasaki discloses " A method of watermarking digital media data at a user device comprising the steps of " as (Sasaki , See abstract , line 9-11, teaches a digital watermark by a user): " receiving encrypted digital media data " as (Sasaki , column 2, line 48-49, teaches receiving an encrypted application for a use of digital work) ; " generating a watermark signal comprising a digital media data content-related information and a user device specific indicator" as (Sasaki , column 2, line 56-61, teaches issuing a license including the identification code of the user device and embedding the license in the digital work by means of a digital watermarks so that the user can use the digital work with the license in the user device); " decrypting the digital media data into decrypted data; decoding the decrypted data into uncompressed data" as [Sasaki , column 8, line 1-3 , teaches a user to decipher or decode license

added by means of digital watermarks of digital work uses on the home pages(uncompressed data)] ; but fails to expressly disclose " and embedding the watermark signal into the uncompressed data.

However, Jian discloses "embedding the watermark signal into the uncompressed data" as [Jian ,Section 2.3, line 15-18, teaches whenever an image is decrypted and rendered , the client's identify information is embedded into this image (uncompressed data)].

Sasaki and Jian are analogous arts beacuse they are the same field of endeavor of the method of watermarking in the digital data for copyright protection.

Therefore, It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to modify the teaching of **Sasaki** by including the client can perform a public watermarking on the digital data that taught by **Jian** because it would provide a low-cost , high-speed watermark embedding process in order to accomplish a real-time online transaction(Section 2.3, line 19-21).

As per claim 2, Sasaki discloses " wherein the digital media content - related information is derived from information contained in copyright license data corresponding to the digital media data" as (Sasaki , column 2, line 66-67, teaches " to add a license to the digital work").

As per claim 3, Sasaki discloses " Wherein the copyright license data includes information that is used to control playback of the digital media data content" as (Sasaki, column 3, line 60-63, teaches the digital rights center can monitor use of digital works having no license or use of digital works having an identification code of a different user).

As per claim 4, Sasaki discloses " Wherein the user device specific indicator includes the user device's unique identification data' as (Sasaki , column 2, line 50-51, teaches an identification code of a user device).

As per claim 5, Sasaki in view of Jian discloses " The method of claim 1, wherein the watermark signal further includes information on the identity of the digital media data content owner" as (Jian, section 2.3, line 1-5, teaches watermark includes the customer identifier to the image).

As per claim 6, Sasaki in view of Jian discloses " The method of claim 2" wherein the digital media data content-related information includes the digital media data content subscriber information" as (Jian, section 2.3, line 1-5, teaches watermark includes the customer name and registration number to the image).

As per claim 7, Sasaki discloses " wherein the digital media data content-related information includes the expiration date of the copyright license"

as (Sasaki , column 3, line 35-38, teaches digital data includes an accounting system to grant a new license on condition that the system has received a payment of a registration, it is obvious that license number has an expiration data).

As per claim 8 , Sasaki discloses " wherein the digital media data content – related information includes information on distribution rights of the copyright license as " as (Sasaki, column 11, line 61-63, teaches ution processing of digital works are arranged by the digital right center).

As per claim 9 ,Sasaki discloses "wherein the digital media data content-related information includes information on the geographical limitations on the copyright license" as (Sasaki, column 4,line 7-10, teaches arranging a digital rights center for an area such as a country, digital works can freely distributed crossing the barriers of national boundaries between different countries).

As per claim 10 , Sasaki discloses " Wherein the digital media data is multimedia data " as (Sasaki , column 1, line 25-28, teaches digitized movie and music are multimedia data).

9. **Claims 11-15 are rejected under 35 U.S.C.103(a) as being unpatentable over Sasaki et al (US 6735699)(hereinafter Sasaki) in view of Jian Zhao(Applying digital watermarking Techniques to online Multimedia Commerce) (hereinafter Jian).**

As per claim 11, Sasaki discloses " A user device adapted and configured to " as (Sasaki , column 4, Fig 1, line 63-67, Fig 1 is configured to register the digital work): " receive encrypted digital media data " as (Sasaki , column 2, line 48-49, teaches receiving an encrypted application for a use of digital work) ; " generate a watermark signal comprising a digital media data content-related information and a user device specific indicator" as (Sasaki , column 2, line 56-61, teaches issuing a license including the identification code of the user device and embedding the license in the digital work by means of a digital watermarks so that the user can use the digital work with the license in the user device); " decrypt the digital media data into decrypted data; decode the decrypted data into uncompressed data" as [Sasaki , column 8, line 1-3 , teaches a user to decipher or decode license added by means of digital watermarks of digital work uses on the home pages(uncompressed data)] ; but fails to expressly disclose " and embed the watermark signal into the uncompressed data.

However, Jian discloses "embed the watermark signal into the uncompressed data" as [Jian, Section 2.3, line 15-18, teaches whenever an

image is decrypted and rendered , the client's identify information is embedded into this image (uncompressed data)].

Sasaki and Jian are analogous arts beacuse they are the same field of endeavor of the method of watermarking in the digital data for copyright protection.

Therefore, It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to modify the teaching of **Sasaki** by including the client can perform a public watermarking on the digital data that taught by **Jian** because it would provide a low-cost, high-speed watermark embedding process in order to accomplish a real-time online transaction(Section 2.3, line 19-21).

As per claim 12, Sasaki discloses " Wherein the digital media data is multimedia data " as (Sasaki , column 1, line 25-28, teaches digitized movie and music are multimedia data).

As per claim 13, Sasaki discloses "wherein the digital media content - related information is derived from information contained in copyright license data corresponding to the digital media data" as (Sasaki , column 2, line 66-67, teaches " to add a license to the digital work").

As per claim 14, Sasaki discloses " Wherein the copyright license data includes information that is used to control playback of the digital media data content" as (Sasaki, column 3, line 60-63, teaches the digital rights center can monitor use of digital works having no license or use of digital works having an identification code of a different user).

As per claim 15, Sasaki in view of Jian discloses " The method of claim 13" wherein the digital media data content-related information includes the digital media data content subscriber information" as (Jian, section 2.3, line 1-5, teaches watermark includes the customer name and registration number to the image).

10. **Claims 16-24 are rejected under 35 U.S.C.103(a) as being unpatentable over Sasaki et al (US 6735699)(hereinafter Sasaki) in view of Jian Zhao(Applying digital watermarking Techniques to online Multimedia Commerce) (hereinafter Jian).**

As per claim 16, Sasaki discloses "A method of enforcing a digital media data content's copyright license" as (Sasaki, column 1, line 7-8 , teaches a method of digital works for copyright license protection); "receiving a digital media data content at a user device" as (Sasaki , column 2, line 48-49, teaches receiving an application for a use of digital work); "decrypting the digital media data content into decrypted data in the user device; decoding the decrypted data into uncompressed data in the user device" as [Sasaki , column 8, line 1-3 ,

teaches a user to decipher or decode license added by means of digital watermarks of digital work uses on the home pages(uncompressed data)]; " receiving a copy right license data in the user device" as (Sasaki , column 2, line 48-49, teaches receiving a permission for a use of digital work at user device); " extracting at least one digital media data content-related information from the copyright license data" as (Sasaki , column 3, line 1-4, teaches a renewal of license is preferable by replacing an old license with a new on after extraction of old one); "generating a watermark signal comprising the at least one digital media content-related information and a user device specific indicator" as (Sasaki , column 2, line 56-61, teaches issuing a license including the identification code of the user device and embedding the license in the digital work by means of a digital watermarks so that the user can use the digital work with the license in the user device); **but fails to expressly disclose** "embedding the watermark signal into the uncompressed data; identifying the watermark signal in a suspect copy of the digital media data content; and determining whether the suspect copy of the digital media data content was distributed according to the copyright license data".

However, Jian discloses "embedding the watermark signal into the uncompressed data" as[Jian,Section 2.3, line 15-18, teaches whenever an image is decrypted and rendered , the client's identify information is embedded into this image (uncompressed data)] ; " identifying the watermark signal in a suspect copy of the digital media data content" as (Jian, Section 3.1, line 15-20,

teaches when a watermark monitor is dedicated to detect the owner-watermark, it produces reports to identity who is using the images that are owned by a specific entity. By comparing the reports with licensing records, copyright infringements can be easily found); and "determining whether the suspect copy of the digital media data content was distributed according to the copyright license data" as (Jian, Section 3.2, line 1-3, teaches a watermark agent acts like a detective to trace any illicit copies by detecting watermarks and verifying the usage rights of image).

Sasaki and Jian are analogous arts beacuse they are the same field of endeavor of the method of watermarking in the digital data for copyright protection.

Therefore, It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to modify the teaching of **Sasaki** by including the client can perform a public watermarking, watermark monitoring and watermark tracking agent on the digital data that taught by **Jian** because it would provide a low-cost, high-speed watermark embedding process in order to accomplish a real-time online transaction(Section 2.3, line 19-21).

As per claim 17, Sasaki discloses " Wherein the digital media data is multimedia data " as (Sasaki , column 1, line 25-28, teaches digitized movie and music are multimedia data).

As per claim 18, Sasaki discloses "wherein the digital media content - related information is derived from information contained in copyright license data corresponding to the digital media data" as (Sasaki , column 2, line 66-67, teaches " to add a license to the digital work").

As per claim 19, Sasaki in view of Jian discloses " The method of claim 16" wherein the digital media data content-related information includes the digital media data content subscriber information" as (Jian, section 2.3, line 1-5, teaches watermark includes the customer name and registration number to the image).

As per claim 20, Sasaki discloses " Wherein the copyright license data includes information that is used to control playback of the digital media data content" as (Sasaki, column 3, line 60-63, teaches the digital rights center can monitor use of digital works having no license or use of digital works having an identification code of a different user).

As per claim 21, Sasaki discloses " Wherein the user device specific indicator includes the user device's unique identification data' as (Sasaki , column 2, line 50-51, teaches an identification code of a user device).

As per claim 22, Sasaki discloses " wherein the digital media data content-related information includes the expiration date of the copyright license" as (Sasaki , column 3, line 35-38, digital data includes an accounting system to grant a new license on condition that the system has received a payment of a registration, it is obvious that license number has an expiration data).

As per claim 23 , Sasaki discloses " wherein the digital media data content – related information includes information on distribution rights of the copyright license as " as (Sasaki, column 11, line 61-63, teaches ution processing of digital works are arranged by the digital right center).

As per claim 24 ,Sasaki discloses "wherein the digital media data content-related information includes information on the geographical limitations on the copyright license" as (Sasaki, column 4,line 7-10, teaches arranging a digital rights center for an area such as a country, digital works can freely distributed crossing the barriers of national boundaries between different countries).

Conclusion

11. The following prior art made of record and not relied upon is cited to establish the level of skill in the applicant's art and those arts considered reasonably pertinent to applicant's disclosure. See MPEP 707.05(c).

12. The following reference teaches execution of trial data.

US 6664976

US 7260722

US 5912972

US 5982892

US 6889211

US 6134659

US 6768807

US 6131161

US 7366300

US 6735699

Applying Digital watermarking techniques to online Multimedia Commerce.

13. Any inquiry concerning this communication or earlier communication form the examiner should be directed to Abu Sholeman whose telephone number is (571)270-7314. the examiner can normally be reached on Monday to Friday 8:30 AM to 5.00PM.

If attempts to reach the above noted Examiner by telephone are un successful, the Examiner's supervisor, Thomas Pham, can be reached at the following telephone number (571)2272-3689.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from the either Private PAIR or public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pari-direct.uspto.gov. Should your have questions on access to the Private PAIR system, contact the Electronic Business Center(EBC) at 866-217-9197(toll-free).

November 3, 2008
/A.S./

Abu Sholeman
Examiner
Art Unit 4148

/Thomas K Pham/
Supervisory Patent Examiner, Art Unit 4148